

04-14-04

Image DAC

PTO/SB/61 (08-03)

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNAVOIDABLY UNDER 37 CFR 1.137(a)**

Docket Number (Optional)

First Named Inventor: RANJIT BANERJEEArt Unit: 1655Application Number: 09/635,027Examiner: ETHAN C. WHISENANT, Ph.DFiled: AUGUST 4, 2000Title: METHODS FOR SIMULTANEOUS ISOLATION OF BIOLOGICALLY
ACTIVE TRANSCRIPTION FACTORS AND DNA

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

NOTE: If information or assistance is needed in completing this form, please contact
Petitions Information at (703) 305-9382.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION.

NOTE: A grantable petition requires the following items:

- (1) Petition fee.
- (2) Reply and/or issue fee.
- (3) Terminal disclaimer with disclaimer fee-required for all utility and plant applications filed before June 8, 1995, and for all design applications; and
- (4) Adequate showing of the cause of unavoidable delay.

1. Petition fee

☒ Small entity - fee \$ 55.00 (37 CFR 1.17(i)). Applicant claims small entity status.
See 37 CFR 1.27.

☐ Other than small entity - fee \$ _____ (37 CFR 1.17(i)).

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of _____ (identify the type of reply):

☐ has been filed previously on _____

☒ is enclosed herewith.

B. The issue fee of \$ _____

☐ has been filed previously on _____

☐ is enclosed herewith.

04/15/2004 MAILING 00000005 09635027

02 FC:2452

55.00 OP

[Page 1 of 3]

This collection of information is required by 37 CFR 1.137(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNAVOIDABLY UNDER 37 CFR 1.137(a)****3. Terminal disclaimer with disclaimer fee**

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. An adequate showing of the cause of the delay, and that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(a) was unavoidable, is enclosed.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

3/30/2004
Date

Arthur I. Degensholtz
Signature

201 692 1292
Telephone Number

ARTHUR IDEGENSHOLTZ
Typed or printed name

22914
Registration Number, if applicable

32 VANDELINDA AVE
Address

TEANECK NJ 07666
Address

- Enclosure ☒ Fee Payment
- ☒ Reply
- ☐ Terminal Disclaimer Form
- ☒ Additional sheets containing statements establishing unavoidable delay
- ☐ _____

CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this correspondence is being:

- ☒ deposited with the United States Postal Service on the date shown below with sufficient postage as first-class mail in an envelope addressed to **Mail Stop Petition**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

- ☐ transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 308-6916.

3/30/2004
Date

Arthur I. Degensholtz
Signature

ARTHUR IDEGENSHOLTZ
Typed or printed name of person signing certificate

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNAVOIDABLY UNDER 37 CFR 1.137(a)**

NOTE: The following showing of the cause of unavoidable delay must be signed by all applicants or by any other party who is presenting statements concerning the cause of delay.

3/30/2004

Date

22 914

Registration Number, if applicable

Arthur I. DeGuzman

Signature

ARTHUR I. DEGUZMAN

Typed or printed name

(In the space provided below, please explain in detail the reasons for the delay in filing a proper reply.)

PLEASE SEE ATTACHED SHEETS 1-7.

(Please attach additional sheets if additional space is needed.)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ranjit Banerjee
Serial No: 09/635,027
Filed: August 4, 2000
Title: METHODS FOR SIMULTANEOUS ISOLATION OF
BIOLOGICALLY ACTIVE TRANSCRIPTION FACTORS AND DNA
Group: 1655
Examiner: Ethan C. Whisenant, Ph.D.

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASON FOR THE DELAY IN FILING A PROPER REPLY SUPPORTING A
PETITION FOR REVIVAL FOR PATENT ABANDONED UNAVOIDABLY UNDER 37
CFR 1.137(a),
TRANSMITTAL OF SEQUENCE LISTING
AND
REQUEST FOR CONTINUING EXAMINATION

RECENT HISTORY

The more recent history associated with this Application as follows:

1. January 10, 2003 Office Letter allowed claims 3-4 and 9-10, stated that Applicant fails to comply with the requirements of sequence listing.
2. July 11, 2003 Office Letter stating that the Application is abandoned in view of a failure to timely file a proper reply to the Office Letter mailed on

June 3, 2002. The Office Letter further states that the proposed reply was received on April 30, 2003 but it does not constitute a proper reply.

3. August 18, 2003 letter(via Fax) informed the Examiner that in accordance with a suggestion received during a telephone conversation with the Examiner and also with Mr. W. Gary Jones the Applicant is in communication with Mr. Mark Spencer of the USPTO Scientific and Technical Information Center Biotechnology Systems Branch, 1911 South Clark Street, Arlington, VA 22202-3521, in order to submit the sequence listing in accordance with USPTO requirements. The submission of a formally compliant readable sequence is believed to be the only outstanding requirement in this application.
4. On August 21, 2003, the Applicant sent an informal letter to Mr. Mark Spencer of USPTO, confirming a telephone conversation they had along with a computer diskette containing the required sequence listing. The content of this diskette was checked by "CHECKER" by the Applicant as specifically directed by Mr. Spencer and a paper copy of the "Verification Summary Report" was submitted with the diskette in order to confirm its accuracy. Mr. Spencer later reviewed this diskette and verbally confirmed to the Applicant during a telephone conversation that the diskette was acceptable as required by USPTO.

SUBMITTAL OF SEQUENCE LISTING

Enclosed, herewith, is a paper copy of the sequence listing together with a computer readable 3.5" diskette containing the required sequence, which is an identical copy of the diskette already verified by Mr. Mark Spencer and found to be acceptable as to USPTO format.

REASONS FOR UNAVOIDABLE DELAY

1. Conversations with Mr. Spencer have now made it clear that the only acceptable sequence format for the USPTO is the sequence format which can be checked and confirmed by "CHECKER".
2. The conventional sequence listing format as previously produced and submitted by the Applicant using the NIH Genbank data base was not capable of producing an acceptable format. For example, the NIH Genbank data base produces the sequence listing with the sequence numbering generally on the left hand side of the page, whereas, the USPTO requires the sequence listing numbering on the right hand side of the page.
3. There was no communication from the USPTO which clearly indicated

that only the specific USPTO software and "CHECKER" will produce acceptable results. There was no clear instructions in the rules or in the Office Letter indicating that only the "CHECKER" software will verify an acceptable sequence format. Following repeated submissions of sequence listings in prepared in the conventional scientific manner, as acceptable in the scientific journals as well as compliant with NIH formats, the USPTO Office Action failed to instruct the Applicant that one can communicate with the USPTO Biotechnology help-line to resolve this sequence submission issue in a timely manner.

4. The Applicant is eminent in the field related to the sequence analyses and, for example, was one of the earlier reviewers for the Genbank data base. Applicant provided sequence listings in a timely manner which were scientifically accurate, as examined and verified by several of his respected peers each holding numerous US patents. However, the Applicant's submission was found to be unacceptable for the reasons of format differences because Applicant's listings were produced by the NIH Genbank software and not the USPTO software.
5. It is believed that this failure to provide acceptable sequence listings was due to the lack of communication and understanding in submitting a relatively small stretch of gene sequences of only 30 and 18 nucleotides, respectively, as required by USPTO using a required software was caused by a USPTO failure to clearly explain the nature of the problem

with the submitted sequences and to clearly indicate that only USPTO softwares, such as PatentIn and Checker, would provide acceptable results. Most importantly, these two relatively small stretches of gene sequences of only 30 and 18 nucleotides, respectively, are not even a part of the patent or 'claims' as previously amended by the examiner. We are required to submit the sequence listing only due to the fact that these two sequences were mentioned in the original application, which can be used as a probe to identify a specific sequence motif binding protein. However, it was also mentioned that any other gene sequences can be potentially used in this regard, and the examiner had suggested to remove this claim in his amended revised version, with the reasoning that the identification or characterization of protein and DNA is not a part of this patent application, only isolation procedure is the main issue.

6. Extensive professional commitments during the months in Fall season of 2003 and also in the early part of 2004, business travel and personal illness on the part of the Applicant have significantly prevented the submission of the present petition.

For the above reasons, it is believed that the present Application should be considered abandoned unavoidably, and should now be allowed. A timely Notice of Allowance will be appreciated.

Enclosed herewith, in accordance with the conversations with the Examiner and also with Mr. W. Gary Jones is a Request for Continuation of Examination (RCE) and a check in the amount of \$385.00 covering the RCE fees. In the event that a review of this petition indicates that a RCE is not needed, it is requested that the RCE fee be credited towards the issue fees.

The following fees are submitted:

Petition fee \$55.00 RCE fee \$385.00. Total \$440.00

Two checks in the amount of \$55 and \$385 are enclosed.

Courtesy and cooperation of W. Gary Jones, Ethan C. Whisenant and Mark Spencer of USPTO are acknowledged.

Respectfully submitted,

By: 

Arthur I. Degenholtz
Agent of Record
USPTO Reg. 22916
32 Vandelinda Ave.
Teaneck, NJ 07666
Tel (201) 692-1292
Fax (201) 692-9764

Dated: 3/30/2004

Enclosures:

1. Two checks in the amount of \$55.00 and \$385.00

2. Computer readable Sequence Listing on one 3.5" disk
3. Sequence listing paper copy as checked by Checker together with the Verification Summary Report



SEQUENCE LISTING

<110> Banerjee, Ranjit

<120> Method for simultaneous isolation of biologically active transcription factors and DNA

<130> RB-99-08

<140> 09/635027

<141> 2003-04-30

<150> 60/147270

<151> 1999-08-05

<160> 2

<170> PatentIn version 3.2

<210> 1

<211> 30

<212> DNA

<213> Human immunodeficiency virus

<400> 1

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<210> 2

<211> 18

<212> DNA

<213> Human immunodeficiency virus

<400> 2

gatccgtgac tcagcgcg 18

PAGE: 1
08/21/2003
12:06:59

VERIFICATION SUMMARY REPORT
PATENT APPLICATION

DATE:
TIME:

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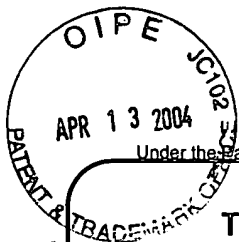
GENERAL INFORMATION SECTION

5,<110> Banerjee, Ranjit
7,<120> Method for simultaneous isolation of biologically
active transcription
8, factors and DNA
10,<130> RB-99-08
12,<140> 09/635027
13,<141> 2003-04-30
15,<150> 60/147270
16,<151> 1999-08-05
18,<160> 2
20,<170> PatentIn version 3.2

ERRORED LINES SECTION

STATISTICS SUMMARY

Application Serial Number: 09/635027
Alpha or Numeric or Xml: Numeric
Application Class:
Application File Date: 2003-04-30
Art Unit:
Software Application: PatentIN3.2
Total Number of Sequences: 2
Total Nucleotides: 48
Total Amino Acids: 0
Number of Errors: 0
Number of Warnings: 0
Number of Corrections: 0

**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Application Number

09/635 027

Filing Date

AUGUST 4 2000

First Named Inventor

RANJIT BAUSERJEE

Art Unit

1655

Examiner Name

ETHAN C. WHISENANT PHD

Total Number of Pages in This Submission

Attorney Docket Number

ENCLOSURES (Check all that apply)

Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)

Response to Missing Parts/
Incomplete ApplicationResponse to Missing Parts
under 37 CFR 1.52 or 1.53

Drawing(s)



Licensing-related Papers



Petition



Petition to Convert to a



Provisional Application



Power of Attorney, Revocation



Change of Correspondence Address



Terminal Disclaimer



Request for Refund



CD, Number of CD(s) _____

After Allowance communication
to GroupAppeal Communication to Board
of Appeals and InterferencesAppeal Communication to Group
(Appeal Notice, Brief, Reply Brief)

Proprietary Information



Status Letter

Other Enclosure(s) (please
Identify below):SEQUENCE LISTING DISK
SEQUENCE LISTING
PAPER COPY

Remarks

ACKNOWLEDGEMENT
POSTCARD☐ Response to the
Incomplete Application
☐ Response to the
USPTO**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**Firm
or
Individual name

ARTHUR I DEGENHOLTZ

Signature

Arthur I Degenholtz

Date

3/30/2004

CERTIFICATE OF TRANSMISSION/MAILING ~~EXHIBIT MAIL - 02314 79812145~~

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Arthur I Degenholtz

Date

3/30/2004

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If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



MAILING CERTIFICATE

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Arthur I. Degenholtz

Agent for Applicant

3/30/2004

Date